

REMARKS

This is a response to the Examiner's Requirement for Information under 37 C.F.R. § 1.105, mailed 24 January 2003. In that request, the Examiner explained to the Applicants that the Examiner was requesting information related to the ST9 family of microcontrollers, based on a statement appearing in a March 1999 article of the *Challenge* publication of STMicroelectronics. Specifically, the Examiner explained that in the "*Onwards and Upwards: New Developments in 8-Bit Micros*" article of the March 1999 issue of the *Challenge* publication, there appears a statement that:

Although it is possible to make part of the Flash memory look like EEPROM by means of software simulation, this approach does not ideal in embedded applications.

For the ST9 and ST10 families, ST offers a unique, patented solution to this problem. The process used is also able to provide hardware emulation of EEPROM functionality . . .

On the basis of this foregoing statement by STMicroelectronics, the Examiner stated:

The cited paragraph indicates the relevance of the ST9 and ST10 disclosures. Moreover, the reference to a "patented solution" implies that there may exist unnamed patents held by the manufacturer of the ST9 and ST10 (i.e. the Assignee) that claim the above specified functionalities.

. . . The ST9 Microcontroller cited in the "Onwards and Upwards" article has apparently been manufactured and sold by the Assignee all the back to 1992.

Examiner's Requirement for Information, page 3 (January 24, 2003).

The Applicants have explored the source of the statement identified by the Examiner (i.e., the statement that there was a "patented solution" for the ST9 which was similar to Applicants' application). Applicants have discovered that the statement identified by the Examiner was a misstatement on behalf of the author of the *Challenge* article. The author of the *Challenge* article should have stated that there was a "patent pending" solution for the ST9. Specifically, Applicants' investigation has revealed that at the time of the article there was no patent on this subject matter owned by ST. In fact the Applicants believe that the "patented solution" referred to in the *Challenge* article was in fact the foreign parent of the application

currently under review by the Examiner. As the Examiner is aware, Applicants claim foreign priority back to European Patent Application No. 98203302.9, filed September 30, 1998. Applicants believe that it was this pending patent application which was referred to in the *Challenge* article.

Accordingly, the above constitutes the list of foreign and domestic patent application numbers referred to in the article *Onwards and Upwards*, according to the best that Applicants have been able to determine at this time. Applicants have inquired of the client and have not been able to locate any issued foreign or domestic patent that corresponds to the material referred to in the article "*Onwards and Upwards: New Developments in 8-Bit Micros.*"

Applicants have also endeavored to obtain information to meet the Examiner's desire for ST9 data sheets. Specifically, please find attached hereto:

- (1) An ST903x/4x Family 8/16 Bit MCU Databook, 1st Edition, dated May 1994.
- (2) A Microcontroller Product Finder, dated 1998. It lists the microcontroller devices promoted by ST. It is Applicants' understanding that the ST9 devices listed, the ST90135x/158 family, do not include any emulated EEPROM.
- (3) A CD-ROM entitled "Data on Disc," dated 1997. Applicants' understanding is that this CD-ROM includes all the data sheets of ST (SGS-Thomson Microelectronics at that time), and thus contains all the ST9 data sheets published at that time.
- (4) The ST9 8/16-bit Microcontroller Family catalog, dated 1994.

The Examiner has requested that Assignee's data sheets and users manuals, dating back to 1992, for the ST9 be provided. In an effort to comply with this request, Applicants have provided the above listed material (1)-(4), copies of which are enclosed. Applicants note that there may exist other technical descriptions of the ST9, for example, there may be other users manuals, application manuals, or other technical descriptions beyond that which is provided herewith; however, it is believed to be merely cumulative and duplicative of the material which is provided. In particular, many companies will print a data sheet each year. It is possible that a data sheet for each of the years that the ST9 has been manufactured may exist. In order to satisfy

this request, Applicants provide the 1997 data sheet which would be the most recent data sheet just prior to the filing of the patent application. Such 1997 data sheet would most likely include the most recent technical advances and most advance description of the product, and therefore it would be merely cumulative and unnecessary to provide a data sheet from 1996, 1995, or prior years since this may be of large bulk and would most likely merely be repetitive of that which is provided.

In order to provide assurance to the Examiner that the ST9 did not incorporate this invention prior to the first effective filing date of the present invention, Applicants have obtained a declaration from an ST employee who is familiar with the ST9. This declaration by the employee makes clear that the ST9 did not use a flash memory to emulate an EEPROM prior to the critical date of the parent patent application.

Applicants hereby submit a facsimile copy of a Declaration by Bertrand Conan, executed in March 2003, wherein Mr. Conan declares that prior to Applicants' priority date, the ST9 did not contain Applicants' claimed invention. The facsimile copy as received is difficult to read because of the poor quality of the facsimile reproduction. In order to provide a copy which is more legible for the Examiner, a clean copy is submitted together with the facsimile copy. The clean copy is identical to the facsimile copy except that the facsimile has been signed and the clean copy has not been signed.

Applicants have endeavored in good faith to comply in all material respects with the Examiner's Requirement for Information. Applicants therefore request that the Examiner indicate that the information provided satisfies his requests. If the Examiner still has questions, or feels that Applicants have not responded as the Examiner desires, Applicants respectfully request that the Examiner contact the undersigned attorney, Mr. Cook, so that Applicants can comply as desired by the Examiner.

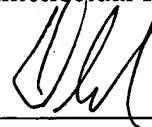
The Commissioner is authorized to charge any additional fees due by way of this Response, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

Maurizio Peri et al.

SEED Intellectual Property Law Group PLLC



Dale R. Cook
Registration No. 42,434

DRC:dma

Enclosures:

Postcard
PTO Form 1449

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

856063.579 / 366986_1.DOC